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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,779	07/27/2001	Ronald J. Skrzyniarz	1945.BDM	8792

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EXAMINER

CHANG, VICTOR S.

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 06/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-5

Office Action Summary

Application No.

09/916,779

Applicant(s)

SKRZYNIARZ ET AL.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-18, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Rejections not maintained are withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 12-18 and 21-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is noted that the many claims in their present form are replete with informalities, vague and indefinite phrases, rendering the claims incomprehensible. For example:

In claim 1, line 2, please correct the term "boned" to --bonded--.

In claim 2, the phrase "foamed to from about 20 to about 60% by volume" is vague, indefinite, and confusing, i.e., it is confusing to the Examiner as to the basis of the "volume". Clarification is requested.

In claim 14, line 2, the phrase "a blend of at least two polyvinyl acetates" is vague, indefinite, and confusing", i.e., does it mean different molecular weights, or a mixture of polyvinyl acetates manufactured by different processes, or anything else? For the purposes of this Office action, it is believed that any commercially available

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"polyvinyl acetate" is a mixture of polymers of different molecular weights, and most likely also a blend from different batches so as to adjust to a desired viscosity of the emulsion product.

In claim 17, lines 1 and 2, the phrase "comprising ... consisting of" appears inappropriate.

In claim 21, line 1, please correct "comprise" to --comprises--.

Response to Amendment

5. Claims 12 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Murphy et al. (US 4036673).

Murphy's invention is directed to installing (i.e., bonding) a sheet of surface covering material on a substrate by a foamed adhesive (Abstract). Murphy teaches that it is known art to form an article by bonding a surface covering material on a substrate such as a floor surface, wall surface, countertop, etc. (column 1, lines 16-18). Murphy also teaches that particularly suitable adhesives including polyvinyl acetate latex, etc. may be utilized (column 3, lines 51-68). It should be noted that the surface covering material and the substrate (in particular a countertop) inherently encompass the high pressure laminate and wood composite, respectively, of the instant claimed invention, as evidenced in the Specification (page 1, second paragraph).

Claims lack novelty.

6. Claims 13-17 and newly added claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy et al. (US 4036673).

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The teachings of Murphy are again relied upon as set forth above.

For claim 13, although Murphy is silent about the foamed volume, it is believed that suitable foamed volume is either inherently disclosed, or an obvious optimization to one skilled in the art, motivated by the desire to reduce the cost.

For claim 14, Murphy expressly teaches that polyvinyl acetate homopolymers and copolymers may be used as the adhesive component of the composition (column 3, lines 54-60), which clearly inherently encompasses the blend of at least two polyvinyl acetates of different molecular weights.

For claims 15-16, it is known art that starch filler has been used to formulate foamed polyvinyl acetate adhesive, as evidenced by the state of the art of Mudge (4692366) which teaches that "up to 50 percent acetylated, casein, hydroxyethyl starch, carboxymethyl cellulose, gum arabic, and the like, are known in the art of synthetic emulsion polymer technology" (column 4, lines 1-5).

For claim 17, in Example 1, Murphy discloses that additive such as a defoaming agent is included in the adhesive composition (column 4, line 40).

With respect to the newly added product-by-process claim 21, it is noted that the method limitations have not been shown on the record to produce a patentably distinct article, as such the formed articles are rendered *prima facie* obvious. It should be pointed out that product-by-process claims are product claims and that to be limiting in a product claim, a process limitation must be evidenced as effecting the structure or chemistry of the resultant product over the prior art. Further, the burden of proof for this

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showing is on Applicant after the Examiner presents an otherwise prima facie rejection.

Note MPEP 2113 for a more detailed description.

For newly added claim 22, although Murphy lacks an express teaching regarding the suitable amounts of polyvinyl acetate and filler, it is believed that these parameters are either inherently disclosed, or an obvious optimization to one of ordinary skill in the art, motivated by the desire to provide adequate adhesion of the laminated product and body, respectively, to the adhesive composition (column 5, line 68).

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC

June 9, 2003

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300-

1700

Daniel Zinker